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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,674	02/04/2004	Marc Ira Lipton	8285/671	5600
7590	08/29/2008	EXAMINER SING, SIMON P		
Peter C. Breen BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610		ART UNIT 2614	PAPER NUMBER	
		MAIL DATE 08/29/2008	DELIVERY MODE PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/772,674	LIPTON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	SIMON SING	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 5/27/2008.
- 2a) This action is **FINAL**.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 34-57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 34-57 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ .  | 6) <input type="checkbox"/> Other: _____ .                        |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. Claims 34-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards et al. US 5,819,029 in view of O'Neal et al. US 5,887,253.

1.1 Regarding claims 34 and 46, Edwards discloses a third party verification system in figure 1, comprising:

a receiver (a telephone interface in the system controller 112) associated with a third party verification (TPV) service to receive, during a telecommunication call, a reply message to confirm an authorized switching to a new long distance service (a telephone service inherently has term and condition) (column 9, line 41 to column 10, line 63; column 12, lines 59-67);

a processor (system controller 112) in communication with the receiver;

a database (IVR response repository 114) in communication with the processor;  
and

wherein the processor creates a record in the database, including audio recordings of affirmative acceptance of the long distance service (column 13, line 66 to column 14, line 23; column 15, lines 27-61).

Edwards teaches verifying, without a service contract, a switch to another a long distance telephone service provider. Edwards is silent on the terms and conditions of a service.

However, O'Neal teaches a voice response unit (VRU) for playing a pre-recorded voice messages (prompts) concerning terms and conditions of a mobile telephone service to a potential customer, and recording responses from the customer. O'Neal teaches prompting the customer, without a contract, to accept terms and conditions, charges and payment, and other contract related provisions (column 13, lines 19-25).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Edwards' reference with the teaching of O'Neal, so that terms and conditions of a communications service would have been played to and accepted by a customer without a contract, because such a modification would have provided proof that a customer understood and approved the terms and conditions of a new service.

1.2 Regarding claim 35, Edwards teaches that a spoken reply message indicates an acceptance of a telephone service (column 10, lines 43-55, 61-63; column 12, lines 64-67).

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1.3 Regarding claims 36 and 47, Edwards teaches recording a subscriber's identity information (column 14, lines 1-2).

1.4 Regarding claim 37, Edwards teaches indicating a service provider identity (column 10, lines 49-51; column 12, lines 64-67).

1.5 Regarding claim 38, Edwards teaches timing information of a call (column 6, lines 44-46).

1.6 Regarding claim 39, Edwards teaches the identity of a calling party (telemarketer) (column 10, lines 11-15).

1.7 Regarding claims 40 and 48, Edwards teaches recording a customer's responses to verification prompts (column 10, lines 61-64).

1.8 Regarding claims 41, 49 and 50, it is inherent that by law, a service provider is required to mail a customer a printed copy of terms and conditions of a service contract (see US 3,999,700, column 3, lines 28-33).

1.9 Regarding claims 42 and 51, Edwards teaches a verbal service message (column 10, lines 49-51; column 12, lines 64-67).

1.10 Regarding claims 43 and 52, Edwards teaches a long distance telephone service (column 10, lines 49-51; column 12, lines 64-67).

1.11 regarding claims 44 and 53, Edwards teaches a voice call initiated by a telemarketer (column 9, lines 41-51).

1.12 Regarding claim 45, Edwards teaches conferencing a telemarketer with the verification process, and in that the telemarketer may speak to the customer on intervene at any time (column 10, lines 24-28).

1.13 Regarding claims 54-57, Edwards teaches prompting a customer to say 'yes' or 'no' to a long distance telephone service (column 12, lines 64-67).

### ***Response to Arguments***

2. Applicant's arguments filed on 10/30/2007 have been fully considered but they are not persuasive.

Applicant contends that Edwards and O'Neal relate to a service contract, whereas the present invention recites: "the terms and conditions are accepted without a contract". Examiner respectively disagrees, for example, claim 34 recites: "a receiver ... to receive ... a reply message to a terms and conditions contract message regarding terms and conditions of a **contract**". Also in the Specification (page 2, lines 9-18), applicant states: "Embodiments of the present invention ... The message can recite an entire terms of the **contract**. The potential subscriber is required to perform an action

to affirmatively accept the **contract**. ... that the subscriber has affirmatively agreed to the terms and conditions of their **contract**". It is clear that the current invention is related to a contract, and the terms and conditions are part of the contract.

As stated in the rejection above, Edwards teaches, without a service contact, prompting a customer to verify an acceptance of a communications service. O'Neal teaches verifying, without a contract, an acceptance of terms, conditions, charges, payment, and other contract provisions. Therefore, both Edwards and O'Neal teach accepting terms and conditions of a service without a contract.

### ***Conclusion***

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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4. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Simon Sing whose telephone number is 571-272-7545.

The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached at 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2600.

/Fan Tsang/

Supervisory Patent Examiner, Art Unit 2614

/Simon Sing/

Examiner, Art Unit 2614

08/28/2008